



#18 / Reply Brief
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PATENT *tu*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael A. Helgeson Examiner: Nguyen, Nam V.
Serial No.: 09/311,092 Group Art Unit: 2635
Filed: May 13, 1999
For: STATE VALIDATION USING BI-DIRECTIONAL WIRELESS LINK
Docket No.: 1004.1123101 (H16-25233)

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REPLY BRIEF

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By:

John G. Shudy, Jr.
John G. Shudy, Jr.

Dear Sir:

This reply is in response to the Examiner's Answer mailed July 14, 2003. The Examiner restated the grounds of rejection relative to the appealed claims from the Final Office Action mailed September 24, 2002. The Appellant very respectfully makes comments below relative to the Examiner's Answer.

A. Relative to the rejection of claims under 35 USC §102 as anticipated by Jacobsen et al., the Examiner stated, "the recitation 'a building monitoring system' has not been given patentable weight because the recitation occurs in the

preamble." The Examiner added, "In the instant application, no references to a building or a building monitor have been addressed in the body of the claims." In the body of the independent claim 1, the last three words of the last element are "building monitoring system." Claims 2-16 are dependent from claim 1. In the second element of independent claim 17, is a recitation of "building monitoring system." Claims 18-22 are dependent from claim 17. The last portion of the first element in the body of claim 23 contains "building monitoring system." Claim 24 depends from claim 23.

Independent method claims 25, 31 and 33 do not have the terms "building monitoring system" in the body of the claim; yet at least one element of the claims "relates" to the building monitoring system. However, the body of each of those claims does depend on the preamble for completeness and the method steps are not able to stand alone. Taking the method steps alone without the disclosed structure in the preamble would render the steps nearly meaningless. For example, the body of independent claim 33 is:

- providing a time signal from said master to said remote;
- waiting while in said non-communicating state for a time interval corresponding to said provided time signal; and
- changing to said transmitting state and transmitting a message after expiration of said time interval.

It is apparent that the context of the preamble of claim 33 is needed to breathe life and provide meaning to the body of the claim. Further, the body of the claim depends on the preamble for completeness.

If the Examiner assumes giving patentable weight to "building monitoring system" in the preamble and assuming it not to be in the body of the claim, the Examiner indicated that a building monitoring system is read as monitoring statistics or monitoring building alarms, or a system for monitoring in a building.

The Examiner stated, "Assuming phrase a building monitoring system is given patentable weight, it is examiner's position that a building monitoring system is read as monitoring building statistics or monitoring building alarms, or a system for monitoring in a building." (Page 17, lines 1-3.) Then the Examiner stated, "Jacobsen et al. teach an individual status unit to be made smaller and provided to residents of long-term care facilities (column 16 lines 46 to 60)." (Page 17, lines 3-5.) Jacobsen et al. do not teach building monitoring systems, but in the lines 46 to 60 of column 16 that the Examiner referred to, Jacobsen et al. indicate that the size of the device could be reduced in size from the military version of the individual status unit because the resident of the care facility could have an individual status unit that "need not be as durable as the military version, and would require a much smaller range for radio communications." (Column 16, lines 50-52.)

The Examiner stated, "When considering the Jacobsen et al. reference, one skilled in the art readily recognizes resident of long term care facilities implies places such as nursing homes." (Page 17, lines 5-6.) The Examiner added, "Clearly these are buildings." (*Id.*, line 7.) The Examiner concluded, "Therefore, when considering the broadest reasonable interpretation of the

claims, Jacobsen et al. anticipate a building monitoring system." (*Id.*, lines 7-8.) That Jacobsen et al. appear to make no reference whatsoever to the building monitoring system amounts to virtually no consideration of a "building monitoring system" in the broadest sense of the claims.

Jacobsen et al. explicitly refer to and disclose various systems for the remote monitoring of personnel. The primary emphasis is on military personnel in the battlefield. In peacetime, Jacobsen et al. note their concept of monitoring physiological variables and location to law enforcement, firefighters, sailors, mountaineers and the like. (Column 1, lines 42-46.) It is not the nursing home or building that is the object of monitorship, for such things as the prevention of harm to the building or harm of the building to the residents. Clearly it is the personnel that are being monitored. For instance, the Examiner noted a military remote monitoring unit, such as a leader/medic unit or a command unit that can keep track of the physiological status and the geolocation of each soldier. After reciting more description of the military system, it was said that clearly Jacobsen et al disclose a monitoring system. However, no monitoring of the building is mentioned in Jacobsen et al., even for statistical purposes or the like. Again, it is the resident or the patient that is being monitored. Such patients or residents could leave the nursing home and still be monitored. If the residents or patients went for a walk outside the home, the outside monitoring of the patients would not be any kind of building monitoring. The nursing home or respective building could be burning down without an indication of such from the personal

monitoring device of a patient outside the home. Inside the home, obviously the monitor might not indicate anything wrong even if the resident or patient was inside while the home was being robbed or on fire.

The Examiner said that the building monitoring system can also include personal monitoring systems within the building. The Examiner said in the Final Office Action of September 24, 2002, "Therefore, the long-term care facilities are similar to a building monitoring system." (Page 3, lines 13-14.) Similarity is not sufficient to support a rejection under 35 U.S.C. §102, as is noted in the Appeal Brief on page 23, lines 15-23 and page 24, lines 1-21.

In the paragraph on page 18, at about lines 7-8, the Examiner said, "The reference is analogous art because the reference deals with remote monitoring system." Whether the cited art is analogous, or not, is irrelevant as to whether a reference anticipates or not. In re Schreiber, 128 F.3d 1473, 1478 (Fed. Cir. 1997); citing In re Self, 671 F.2d 1344, 1350 (CCPA 1982). The Appellant did not argue that the art was analogous relative to the 35 USC §102 rejection. Also, the Appellant did not argue that the reference "teaches away from the invention" in response to the §102 rejection. The use of the term "applicable" does not mean "analogous" nor is it a term of art relevant to a particular rejection analysis. It raises the question of whether the art anticipates or not. It does not argue against or for analogousness. Thus, the paragraphs in about lines 5-22 on page 18 and lines 1-2 on page 19 of the Examiner's Answer are not germane to this portion of the response.

Perhaps appropriately, the Examiner could have discussed the standard for anticipation which requires identity of invention. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026, 104 S. Ct. 1284 (1984). Thus, "[t]he identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, (Fed. Cir. 1989), citing Jamesbury Corp. v. Litton Industrial Products, Inc., 756 F.2d 1556, 1560 (Fed. Cir. 1985); Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983). "In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984). "While the teaching in the prior reference need not be *ipsissimis verbis*, nevertheless, there must be a teaching with respect to the entirety of the claimed invention." Structural Rubber Prods Co. v. Park Rubber Co., 749 F.2d 707, 716 (Fed. Cir. 1984). "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Id.*, at 716, citing Soundsciber Corp. v. U.S., 360 F.2d 954, 960, (Ct. Cl. 1966). Similarity is not adequate to support a rejection under 35 U.S.C. §102.

B. Relative to the rejection of the claims under 35 USC §102 as anticipated by Reis et al., the Examiner indicated, as mentioned earlier in his answer, that the recitation of "a

building monitoring system" and "a method for communicating between a remote unit and a master unit in a radio-frequency building monitoring system" has not been given patentable weight because the recitation occurs in the preamble. The Examiner added that in the application, "no references to a building or a building monitor have been addressed in the body of the claims." Hesitant to repeat the above statements here, the Appellant wishes to point out in the body of the independent claim 1, the last three words of the last element are "building monitoring system." Claims 2-16 are dependent from claim 1. In the second element of independent claim 17 is a recitation of "building monitoring system." Claims 18-22 are dependent from claim 17. In the last part of the first element in the body of claim 23 is "building monitoring system." Claim 24 depends from claim 23.

Independent method claims 25, 31 and 33 do not have the terms "building monitoring system" in the body of the claim; yet at least one element of each claim "relates" to the building monitoring system. However, the body of each of those claims does depend on the preamble for completeness and the method steps of those claims are not able to stand alone. Taking the method steps alone without the disclosed structure in the preamble would render the steps nearly meaningless as stated above. The bodies of the claims depend on their respective preambles for completeness.

As to Reis et al. pagers having local communication ranges suitable for warehouses, buildings, vehicles and other similar local regions do not make them a building monitor because it has that attribute of ranges. Many other RF devices have such

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ranges and are not and should not be regarded as building monitors because of such an attribute.

The Examiner refers to a portion of Reis et al. relative to claims 23-29 and 31-34 that deals with communication between two units, a remote unit communicating with a master in a building, an identification pager for personnel within an industrial facility, the pager receiving a signal indicative of entry into a restricted zone and automatically transmitting an identification response signal which triggers a central system to write the event into an access log and unlock certain access controls. This system is for the personal benefit of the users of the pager system.

To paraphrase the Examiner, as noted above, the VHF radio frequency used is in an air communication medium so that the transmitter power, antenna size requirements and device range capability are satisfactory for local communication ranges suitable for warehouses and so forth. In conclusion, the Examiner argued that Reis et al. anticipate a method for communicating between a remote unit and a master unit in a radio frequency building monitoring system. Actually, Reis et al. did not make the pager system a part of a building monitoring system. In Reis et al., the pager system is a personal communication system for the personnel using it to communicate and to achieve certain tasks such as entry into restricted space, coordinating activities with others, and for personal monitoring. Even though the pager system may be used in a building does not mean that it is a building monitoring system.

The Examiner's comments relative to Reis et al. being analogous art is not relevant under the 35 USC §102 rejection as

the Appellant did not contend Reis et al. to be analogous nor to teach away. This point is discussed above with respect to Jacobsen et al.

C. Relative to claims 21 and 22, the Examiner argued that Jacobsen et al. show a building monitoring system and anticipate variables. The Appellant very respectfully disagrees for the reasons stated above and in Paragraph C of the Argument in the Appeal Brief.

D. Relative to claim 30, the Examiner's argument that a rejection of that claim may be sustained with the combination of Jacobsen et al. and Reis et al. is based on the assumptions that Reis et al. and Jacobsen et al. are analogous art, which the Applicant very respectfully disputes in Paragraphs C and D of the Appeal Brief.

E. Pursuant to 37 CFR §1.192(c)(7), the Appellant asserted that claims 1-22 stand or fall together and that claims 23-34 stand or fall together. Per 37 CFR §1.192(c)(8), the reasons that these groups are that claims 1-22 concern a building monitoring system and claims 23-34 concern a method for communicating between a remote unit and a master unit in a radio-frequency building monitoring system, which the Appellant believes are separately patentable. The Appellant further believes that if any of the independent claims fall, at least some of the dependent claims could stand alone and would be separately patentable.

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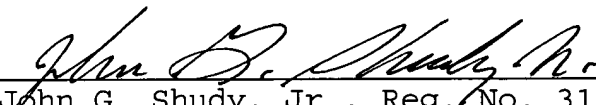
Respectfully submitted,

Michael A. Helgeson

By his Attorney,

Date:

09/12/03



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Applicant: Michael A. Helgeson

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For: STATE VALIDATION USING BI-DIRECTIONAL WIRELESS LINK

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By

John G. Shudy, Jr.

We are transmitting herewith the attached:

- [X] Reply Brief in response to Examiner's Answer dated July 14, 2003.
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